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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/059,278	01/31/2002	Larry E. Mashburn	T2317-907720	5374

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/059,278

Applicant(s)

MASHBURN ET AL.

Examiner

Cheryl Juska

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01-31-02</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. The claim limitation recited at the top of page 23 (between claims 26 and 27) is a dangling limitation not associated with either claim. As such, said limitation is not examined.

Double Patenting

2. Claim 12 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 4. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4 or 6 of copending Application No. 10/097439. Although the conflicting claims are not identical, they are not patentably distinct

Art Unit: 1771

from each other because, with respect to claim 4, it would have been obvious to select the claimed multifunctional alcohol as the cross-linking agents since said alcohols are readily known in the art as cross-linkers for polyurethane reactions. With respect to claim 6, it would have been obvious to add a catalyst to the claimed polyurethane composition, since said catalysts are readily known in the art of polyurethanes.

5. Similarly, independent claim 26 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 27 of copending Application No. 10/097439. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to select the claimed multifunctional alcohol as the cross-linking agent and to add a catalyst since said cross-linking alcohols and catalysts are readily known in the art of polyurethanes.

6. Dependent claims 2-12 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 3, 5, 7-13, and 5, respectively, of copending Application No. 10/097439.

7. Dependent claims 13-25 and 30-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 14-26 and 28-33, respectively, of copending Application No. 10/097439.

8. These are provisional obviousness-type double patenting rejections because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102/103

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-16, 18, 19, 22, 26-29, and 32 are rejected under 35 USC 102(e) as being anticipated by, or in the alternative under 35 USC 103(a) as being unpatentable over US

2002/0090488 issued to Kurth et al.

Kurth discloses a bio-based carpet comprising a tufted face, a primary backing, a pre-coat, and a backing material (abstract). The pre-coat and the backing material comprise the reaction product of (A) an isocyanate and (B) a polyol, a vegetable oil, cross-linker, and a catalyst (abstract and claim 1). The isocyanate is preferably a diisocyanate such as 2, 4-diisocyanate, 4, 4'-diphenylmethane diisocyanate, or 2, 4-diphenylmethane diisocyanate (claim 2). The vegetable oil may be a blown vegetable oil, such as soy, rapeseed, or palm oil (claims 13 and 14). The cross-linker comprises one or more multifunctional alcohols, such as ethylene glycol and butanediol (claims 7-9). The catalyst is a tertiary amine, such as DABCO 33-LV[®] (i.e., 33%

Art Unit: 1771

1,4-diaza-bicyclo-octane and 67% dipropylene glycol) (claim 10 and section [0049]).

Component (B) may also include a blowing agent, such as methyl isobutyl ketone, acetone, or water (claim 5 and section [0046]) or a surfactant for influencing the foam cell size (section [0050]). Additionally, a molecular sieve agent may be added to absorb excess water from the reaction mixture (section [0051]). The ratio of component A to component B ranges from 20 parts A per 100 parts B (section [0234]) to 131 parts A per 100 parts B (section [0344]). Specific working examples fall within the claimed ratio of 70-85 parts A to 100 parts B (e.g., sections [0158], [0383], and [0414]).

Thus Kurth teaches the limitations of claims 1-16, 18, 19, 22, 26-29, and 32 with the exception of (a) the claimed mole ratio of OH groups of the multifunctional alcohol to vegetable oil and (b) the claimed amounts of soy oil, cross-linker, catalyst, blow agent, surfactant, and molecular sieve. Kurth does disclose numerous specific compositions, but does not disclose the compositions in terms of a mole ratio of OH groups or parts by weight. Thus, without numerous calculations, a direct comparison of the present invention and the Kurth invention cannot be made with respect to the composition amounts. However, it is asserted that the claimed mole ratio and component amounts are inherent to the disclosed composition of Kurth. Support for said assertion is in the use of like components (i.e., isocyanate, vegetable oil, catalyst, cross-linker, blow agent, surfactant, and molecular sieve) of the polyurethane composition and the like end products (i.e., polyurethane backed carpet). Therefore, claims 1-16, 18, 19, 22, 26-29, and 32 are rejected as being anticipated by the cited Kurth reference.

12. In the alternative, it would have been obvious to one skilled in the art to select the claimed mole ratio and amounts, since it has been held that where the general conditions of the

Art Unit: 1771

claim are disclosed in the prior art discovering workable ranges only involves routine skill in the art. *In re Aller*, 105 USPQ 233. Therefore, claims 1-16, 18, 19, 22, 26-29, and 32 are rejected as being obvious over the cited Kurth reference.

Claim Rejections - 35 USC § 103

13. Claim 17 is rejected under 35 USC 103(a) as being unpatentable over the cited Kurth reference.

Kurth does not explicitly teach the claims coating weight. However, it would have been obvious to one skilled in the art to select the claimed coating weight, since it has been held that where the general conditions of the claim are disclosed in the prior art discovering workable ranges only involves routine skill in the art. *In re Aller*, 105 USPQ 233.

14. Claims 20, 21, 24, 25, 30, 31, 34, and 35 are rejected under 35 USC 103(a) as being unpatentable over the cited Kurth reference in view of US 6,060,145 issued to Smith et al.

Kurth fails to teach the presence of a secondary backing comprising a woven fabric, a nonwoven fabric, or a composite woven/nonwoven fabric. However, said secondary backings are well known in the art. For example, Smith teaches conventional secondary backings are woven polypropylene scrims, while the invention of Smith comprises a woven/nonwoven composite secondary backing (col. 1, lines 34-44, col. 7, lines 29-40, and col. 8, lines 46-64). Thus, it would have been obvious to one skilled in the art to employ a secondary backing fabric, as is well known in the art, to the polyurethane backed carpet of Kurth, with the expectation of producing a finished carpet product suited for commercial use.

Art Unit: 1771

15. Claims 23 and 33 are rejected under 35 USC 103(a) as being unpatentable over the cited Kurth reference in view of US 2003/0114062 issued to Scott et al.

Kurth fails to teach a secondary textile laminated between the two polyurethane coatings (i.e., pre-coat and foam backing material). However, it is well known to employ such a textile between a pre-coat layer and foam backing layer in order to enhance the dimensional stability of the carpet. For example, Scott teaches a reinforcing fabric between a pre-coat layer and a resilient (i.e., foam) layer (section [0082] and Figure 1). Thus, it would have been obvious to one skilled in the art to employ a reinforcing scrim between the pre-coat and the foam cushion layer of the Kurth polyurethane in order to enhance the stabilization of the carpet.

Conclusion

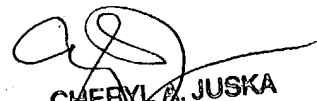
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

Art Unit: 1771

system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CHERYL A. JUSKA
PRIMARY EXAMINER

cj
February 7, 2004